

REMARKS

Applicants have cancelled claims 34-57 without prejudice or disclaimer. As a result, claims 1-33 are currently pending in the present application.

In section 7 of the Official Action the Examiner states that claims 1-34 are directed to an invention not patentably distinct from claims 6, 15, 16, 19, 20, 22, 25-41, 47 and 48 of commonly assigned U.S. Patent No. 6,443, 258 B1.

To resolve this issue, Applicants attorney hereby submits that the presently claimed invention and U.S. Patent No. 6,443,258 B1 were, at the time the invention of the present application was made, subject to an obligation of assignment, to Armstrong World Industries, Inc. Thus, U.S. Patent No. 6,443,258 B1 should be disqualified as prior art under 35 U.S.C. 103(c).

In section 11 of the Official Action the Examiner states that claims 1, 4-19, 22-26 and 28-33 are directed to an invention not patentably distinct from claims 1, 4, 9, 11, 15, 16, 20, 24, 26-28 and 35 of commonly assigned U.S. Patent No. 6,613,424 B1.

To resolve this issue, Applicants attorney hereby submits that the presently claimed invention and U.S. Patent No. 6,613,424 B1 were, at the time the invention of the present application was made, subject to an obligation of assignment, to Armstrong World Industries, Inc. Thus, U.S. Patent No. U.S. Patent No. 6,613,424 B1 should be disqualified as prior art under 35 U.S.C. 103(c).

In section 13 of the Official Action the Examiner states that claims 1, 4-11, 16, 17, 19, 22-26, 28 and 33 are directed to an invention not patentably distinct from claims 1, 4, 8, 29-31 and 33-34 of commonly assigned U.S. Patent Application No. 10/384,240 or U.S. Patent Publication No. 2003/0178250 A1.

To resolve this issue, Applicants attorneys hereby submit that the presently claimed invention and U.S. Patent Application No. 10/384,240 (U.S. Patent Publication No. 2003/0178250 A1) were, at the time the invention of the present application was made, subject to an obligation of assignment, to Armstrong World Industries, Inc. Thus, U.S. Patent Application No. 10/384,240 or U.S. Patent Publication No. 2003/0178250 A1 should be disqualified as prior art under 35 U.S.C. 103(c).

Obvious-Type Double Patenting Rejections

Claims 1-12 and 16-34 have been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 6, 15, 16, 19, 20, 22, 25-41, 47 and 48 of U.S. Patent No. 6,443,258 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al.

Claim 13 has been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 6, 15, 16, 19, 20, 22, 25-41, 47 and 48 of U.S. Patent No. 6,443,258 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al. and either U.S. Patent No. 4,940,629 to Weber et al or U.S. Patent No. 5,753,718 to Jacks.

Claims 14 and 15 have been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 6, 15, 16, 19, 20, 22, 25-41, 47 and 48 of U.S. Patent No. 6,443,258 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al. and U.S. Patent No. 2,189,889 to Engel.

Claims 1, 4-12, 16-19, 22-26 and 28-33 have been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 4, 9, 11, 15, 16, 20, 24, 26-28 and 35 of U.S. Patent No. 6,613,424 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al.

Claim 13 has been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 4, 9, 11, 15, 16, 20, 24, 26-28 and 35 of U.S. Patent No. 6,613,424 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al. and either U.S. Patent No. 4,940,629 to Weber et al or U.S. Patent No. 5,753,718 to Jacks.

Claims 14 and 15 have been rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 4, 9, 11, 15, 16, 20, 24, 26-28 and 35 of U.S. Patent No. 6,613,424 B1 in view of U.S. Patent No. 4,613, 627 to Sherman et al. and U.S. Patent No. 2,189,889 to Engel.

Claims 1, 4-11, 16, 17, 19, 22-26, 28 and 33 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 4, 8, 29-31, 33 and 34 of either copending U.S. Patent Application No. 10/384,240 or U.S. Patent Publication No. 2003/0178250 A1 to Putt et al. in view of U.S. Patent No. 4,613, 627 to Sherman et al.

To alleviate the obvious-type double patenting objections, Applicants are submitting herewith a timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) to overcome all of the non-statutory double patenting rejections. The present application, U.S. Patent No. 6,443,258, U.S. Patent No. 6,613,424 and U.S. Patent Application No. 10/384,240 (U.S. Patent Publication No. 2003/0178250 A1) are commonly assigned to AWI Licensing Company. The present application, as well as pending U.S. Patent Application No. 10/384,240 (U.S. Patent Publication No. 2003/0178250 A1), have been assigned to AWI Licensing Company by Assignments executed on March 22, 2004, of which copies are enclosed.

Pursuant to MPEP 804.04 (IV), a single Terminal Disclaimer document is submitted herewith, wherein each one of the conflicting double patenting references are disclaimed therein. As a result of the Terminal Disclaimer, Applicants respectfully request that all of the obvious-type double patenting rejections be withdrawn.

If it is believed that any issues remain unresolved in the application, Applicants request that the Examiner contact the undersigned.

Respectfully submitted,

4/5/04
Date

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ASSIGNMENT OF UNITED STATES PATENT APPLICATION

THIS ASSIGNMENT OF INTELLECTUAL PROPERTY (the "Assignment") is made as of this 22nd day of March, 2004, (the "Effective Date"), by and between Armstrong World Industries, Inc., 2500 Columbia Avenue, P. O. Box 3001, Lancaster, Pennsylvania 17604-3001, a Pennsylvania corporation ("Assignor"), and, AWI Licensing Company, 802 West Street, Wilmington, Delaware 19801, a Delaware corporation ("Assignee").

WITNESSETH:

WHEREAS, Assignor is the record owner of U.S. Application Serial No. 10/384,240, filed March 7, 2003, entitled Acoustical Panel Having a Honeycomb Structure and Method of Making The Same ("the Application");

WHEREAS, Assignor desires to assign, transfer and convey to Assignee all worldwide right, title and interest in and to the Application and all worldwide right, title and interest in and to all Letters Patent that may issue in the United States and its territories from the Application; and

WHEREAS, Assignor and Assignee desire to confirm the assignment of the Application to Assignee;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged:

1. Assignor hereby assigns, transfers and conveys to Assignee, its successors and assigns, the entire worldwide right, title and interest in and to all Letters Patent that may issue in the United States and its territories from the Application and any and all reissues, corrections and extensions thereof arising in the United States and its territories, as well as all causes of action, claims, demands and other rights for, or arising from, any infringement, including past infringements, of the Application and the Letters Patent.
2. Assignor represents and warrants to Assignee that: (i) Assignor has not previously transferred, assigned, licensed, or otherwise encumbered the Application and (ii) Assignor will not take any action to interfere with Assignee's right, title and interest in and to the Application.
3. Assignor further represents and warrants to Assignee that, upon the execution and delivery of this Assignment, Assignee will be vested with the entire right, title and interest in and to the Application, free and clear of all liens, claims, licenses or other encumbrances.
4. Assignor further agrees, without further consideration, to perform or cause to be performed such other lawful acts and to execute or cause to be executed such confirmatory assignments and other legal documents as Assignee, or its counsel, may from time to time reasonably request to effect fully this Assignment and to permit Assignee to be duly recorded as the registered owner of each of the rights hereby conveyed.

